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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,753	03/09/2001	Thomas Edward Peach	2503/69173	4555

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EXAMINER
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MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/801,753

Applicant(s)

PEACH, THOMAS EDWARD

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/5/06 has been entered.

### ***Notice to Applicant***

2. This communication is in response to the amendment filed 9/5/06. Claims 1-14 are presented for examination.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,526,386 to Chapman et al. in view of U. S. Patent No. 6,519,568 to Harvey et al.

As per claim 1, Chapman et al. teaches a system for inputting and collecting insurance information from a plurality of remotely connected agents, said system comprising:

--the claimed forms database, said forms database including completed human-readable insurance forms is met by a file that includes a paper file and data relating to a particular insurance policy or the insured, and also similar data stored on a computer in a computer

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database or other computer file (see: column 3, lines 17-21). In addition, Chapman teaches database (128, Fig. 1) and database (132, Fig. 1) (see: column 3, lines 65 to column 4, lines 14); and

--the claimed formatting computer in communication with the forms database and operative to format human-readable forms with individual client information, and to provide completed forms to the forms database is met by the remote computer terminal (104, Fig. 1) at the insurance agent's location that is connected by secure private network (106, Fig. 1) to the central computer (124, Fig. 1) in the form of a Citrix™ Winframe Enterprise Server (see: column 3, lines 56-62). In addition, stored in the central computer is a policy status database (128, Fig. 1) (see: column 2, lines 65 to column 3, lines 2). Furthermore, all the prior art needs to show is a formatting computer that is capable of (i.e., operative to) format forms; and

--the claimed network server providing remote access to said forms database and operative to receive the individual client information from said remotely connected agents for formatting by the formatting computer is met by the remote computer terminal (104, Fig. 1) at the insurance agent's location that is connected by a secure private network (106, Fig. 1) to the central computer (124, Fig. 1) in the form of a Citrix™ Winframe Enterprise Server (see: column 3, lines 56-62). Furthermore, the prior art need only show a formatting computer that is capable of (i.e., operative to) receive client information.

Chapman et al. fails to teach the claimed data transfer server operative to transfer the complete forms to a plurality of remotely located terminals.

Harvey et al. teaches a system and method for electronic data delivery that includes a transfer server (153, Fig. 10) used to upload/download files (see: column 20, lines 51-57).

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Furthermore, the prior art need only show a server that is capable of (i.e., operative to) transfer forms to remotely located terminal, which the prior art does.

One of ordinary skill in the art at the time the time invention was made would have found it obvious to include transfer server as taught by Harvey et al. within the system and method of generating automobile insurance certificate from remote computer terminals as taught by the Chapman et al. with the motivation of providing a system that offers seamless delivery of real-time data from acquisition sites to delivery sites with an integration of all data streams (see: Harvey et al.: column 3, lines 19-22).

As per claim 2, Chapman et al. teaches the claimed remotely connected agents are connected over remotely located terminals, said remotely located terminals being connected to said remote server over a network, agents providing client information to said forms database from corresponding ones of said remotely connected terminals. This limitation is met by the remote computer terminal (104, Fig. 1) at the insurance agent's location that is connected by secure private network (106, Fig. 1) to the central computer (124, Fig. 1) in the form of a Citrix™ Winframe Enterprise Server (see: column 3, lines 56-62). Furthermore, at step 300 an insurance agent enters data into policy status database (128, Fig. 3) by means of software interface (126, Fig. 3) from remote terminal (104, Fig. 3).

As per claim 3, Chapman et al. teaches data relating to automobile insurance policies (reads on "completed insurance applications") are stored in the policy status database (128, Fig. 1) (see: column 3, lines 65-67).

Chapman et al. fails to teach a data transfer server comprises a file transfer protocol (FTP) server.

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Harvey et al. teaches a FTP application server (122, Fig. 9B) that sends files to an external server using FTP protocol (see: column 19, lines 29-31).

The obviousness of combining the teachings of Harvey et al. within the system as taught by Chapman et al. are discussed in the rejection of claim 1, and incorporated herein.

As per claim 4, Chapman et al. teaches data relating to automobile insurance policies (reads on “completed forms”) are stored in the policy status database (128, Fig. 1) (see: column 3, lines 65-67).

Chapman et al. fails to teach a data transfer server comprises an e-mail server and e-mailed to a registered originating agent.

Harvey et al. teaches a notification application server (123, Fig. 9B) used to send e-mail messages, with optional attachments (see: column 19, lines 31-32).

The obviousness of combining the teachings of Harvey et al. within the system as taught by Chapman et al. are discussed in the rejection of claim 1, and incorporated herein.

As per claim 5, Harvey et al. teaches the claimed e-mail server includes a database, said database including e-mail addresses of registered insurance agents. This limitation is met by the notification application server (123, Fig. 9B) used to send e-mail messages, with optional attachments (see: column 19, lines 31-32, column 20, lines 61-64 and column 15, lines 55-62).

As per claim 6, Chapman et al. teaches a forms database further includes client information and information relating to new business information. This feature is met by file that includes data relating to a particular insurance policy or the insured, and also similar data stored on a computer in a computer database or other computer file (see: column 3, lines 17-21). In addition, Chapman teaches database (128, Fig. 1) and database (132, Fig. 1) and cancellation and

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renewal forms which are sent to a remote computer terminal (146, Fig. 1) at the insurance carrier office for viewing or printing (see: column 3, lines 65 to column 4, lines 14 and column 4, lines 21-37). This suggests that a file includes insurance policies information used for cancellations or renewals that could include possible renewal such as adding another vehicle or modifying the current policy information (new business information).

As per claim 7, Chapman et al. teaches remote computer terminals (104, Fig. 1) at the insurance agent's location that is connected by secure private network (106, Fig. 1) to the central computer (124, Fig. 1) in the form of a Citrix™ Winframe Enterprise Server (see: column 3, lines 56-62). In addition, Chapman et al. teaches data relating to automobile insurance policies are stored in the policy status database (128, Fig. 1) (see: column 3, lines 65-67).

Chapman et al. fails to teach a compression means for compressing form images for a single client into a single compressed file.

Harvey et al. teaches a data compression module for compressing data transmitted over the first, second and third communications network (see: column 7, lines 35-37). In addition, Harvey et al. teaches that the application server (127, Fig. 10) support data transfer of data from the acquisition site and client delivery sites (see: column 19, lines 46-48).

The obviousness of combining the teachings of Harvey et al. within the system as taught by Chapman et al. are discussed in the rejection of claim 1, and incorporated herein.

As per claim 8, Harvey teaches a data transfer server comprises:

--the claimed e-mail server is met by the notification application server (123, Fig. 9B) used to send e-mail messages, with optional attachments (see: column 19, lines 31-32, column 20, lines 61-64 and column 15, lines 55-62); and

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--the claimed file transfer protocol (FTP) server, compressed files below a selected size being e-mailed over said e-mail server to a registered agent, said compressed file being included with said e-mail and, compressed files exceeding said selected size being stored on said FTP server, said registered agent being notified of said stored compressed file location is met by the notification application server (123, Fig. 9B) used to send e-mail messages, with optional attachments (see: column 19, lines 31-32, column 20, lines 61-64 and column 15, lines 55-62). In addition, Harvey et al. teaches a FTP application server (122, Fig. 9B) that sends files to an external server using FTP protocol (see: column 19, lines 29-31). Furthermore, Harvey et al. teaches a data compression module for compressing data transmitted over the first, second and third communications network (see: column 7, lines 35-37).

As per claim 9, Chapman et al. teaches the claimed insurance policy forms include insurance policy application and contact forms (see: Fig. 9 and 10, especially name and address or agency or Office issuing).

As per claim 10, Chapman et al. teaches the claimed client data includes insurance policy application and contract data (see: Fig. 9 and 10, especially name and address or agency or Office issuing).

As per claims 11-14, they are rejected for the same reasons set forth in claims 1-9.

### ***Response to Arguments***

5. Applicant's arguments filed 12/16/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response 12/16/05.



(A) In the remarks, Applicants argue in substance that, (1) there is no disclosure or suggestion in Chapman that the databases 128 and 132 includes completed forms and remote computer provides completed forms to the database; (2) there must be some motivation established outside the present application as the basis for the combination; (3) with regards to claims 3 and 12, an FTP server is most appropriate for very large files and an application for insurance is different from an issued policy; and (4) there is no motivation to introduce Harvey with the system of Chapman because they are inappropriate for the purpose of Chapman.

(B) In response to Applicants arguments that (1) there is no disclosure or suggestion in Chapman that the databases 128 and 132 include completed forms and remote computer provides completed forms to the database. The Examiner respectfully submits that the Chapman reference teaches a file that includes data relating to a particular insurance policy or the insured, and also similar data stored on a computer in a computer database or other computer file (see: column 3, lines 17-21). In addition, Chapman teaches database (128, Fig. 1) and database (132, Fig. 1) (see: column 3, lines 65 to column 4, lines 14). Furthermore, Chapman teaches a remote computer terminal (104, Fig. 1) at the insurance agent's location that is connected by secure private network (106, Fig. 1) to the central computer (124, Fig. 1) in the form of a Citrix™ Winframe Enterprise Server (see: column 3, lines 56-62). In addition, stored in the central computer is a policy status database (128, Fig. 1) (see: column 2, lines 65 to column 3, lines 2). Furthermore, all the prior art needs to show is a formatting computer that is capable of (i.e., operative to) format forms.

(C) In response to Applicants arguments that (2) there must be some motivation established outside the present application as the basis for the combination and (4) there is no

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motivation to introduce Harvey with the system of Chapman because they are inappropriate for the purpose of Chapman. The Examiner respectfully submits that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the above Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, the motivation to combined the teachings of the Harvey within the Chapman reference is given in the above Office Action from a passage in the Harvey column 3, lines 19-22, "providing a system that offers seamless delivery of real-time data from acquisition sites to delivery sites with an integration of all data streams".

(D) In the remarks, Applicants argue in substance that, (3) with regards to claims 3 and 12, an FTP server is most appropriate for very large files and an application for insurance is different from an issued policy. The Examiner respectfully submits that the Harvey reference, and not Chapman, *per se*, that was relied upon for the specific teaching of a FTP application

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server (122, Fig. 9B) that sends files to an external server using FTP protocol (see: column 19, lines 29-31). In addition, Harvey et al. teaches a data compression module for compressing data transmitted over the first, second and third communications network (see: column 7, lines 35-37). Chapman is relied for primarily teaching a file that includes data relating to a particular insurance policy (application) or the insured, and also similar data stored on a computer in a computer database or other computer file (see: column 3, lines 17-21). Thus, the proper combination of the applied references would be the incorporation of Harvey's transfer server within the system and method of generating automobile insurance certificate from remote computer terminals of Chapman. Therefore, Harvey's FTP protocol is capable of transferring large files as well as compressing the file before it is transferred. Additionally, Chapman's files, which are stored in databases, suggest that completed insurance application forms are included with the renewals and cancellation forms since they are generated from a previously completed insurance application.

In response to Applicant other argument, it is respectfully submitted that the Examiner has applied recited new passages and citations to amended claims 1, 6 and 11 at the present time. The Examiner notes that amended limitations were not in the previously pending claims as such, Applicant's remarks with regard to the application of Chapman and Harvey to the amended limitations are addressed in the above Office Action.

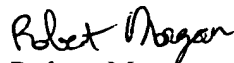
### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Robert Morgan  
Patent Examiner  
Art Unit 3626